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C. REMARKS

1. Summary of the Claims

Claims 1-20 are currently pending in the application. Claims 1, 8, and 14 are independent claims. Claims 1, 6, 8, 12, 14, and 19 have been amended to correct inadvertent, typographical errors. No claims have been canceled or added. No new matter has been added. Reconsideration of the claims is respectfully requested.

2. Examiner Interview

Applicant notes with appreciation the telephonic interview conducted between Applicant's representative and the Examiner on March 8, 2005. During the telephonic interview, the Examiner and Applicant's representative discussed one of the 103 references (Hibino et al., U.S. Patent No. 5,909,241). In particular, Applicant's representative emphasized that Applicant's invention displays thumbnails concurrently with a larger image that corresponds to one of the thumbnails thumbnail on a single display window. In contrast, Applicant's representative pointed out that the Office Action's reference to Hibino teaches various approaches for showing film image frames whose magnetic information is rewritten but, however, at no time does Hibino teach or suggest displaying a larger image concurrently with thumbnails on a single display window. The Examiner suggested sending in a response to the Office Action, which he will review in more detail.

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3. Drawings

Applicant notes that the Examiner did not indicate whether the formal drawings, filed with Applicant's application, are accepted by the Examiner. Applicant respectfully requests that the Examiner indicate whether the formal drawings are accepted in the next office communication.

4. Claim Rejections 35 U.S.C. § 103

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Santoro et al. (U.S. Patent No. 6,724,403, hereinafter "Santoro") in view of Hibino et al. (U.S. Patent No. 5,909,241, hereinafter "Hibino"). Applicant respectfully traverses these rejections.

Applicant asserts that the Office Action fails to establish a prima facie case of obviousness under § 103 as set forth in § 103 and the MPEP. MPEP 2142 states that:

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

Applicant asserts that the Office Action fails to show that the prior art references teach or suggest all of Applicant's claim limitations. As described in further detail below, Santoro and Hibino fall far short of teaching each and every element of Applicant's independent claims. Comparing

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Applicant's claim limitations with the sections of Santoro and Hibino cited in the Office Action make this amply clear.

In addition, Applicant asserts that the Office Action fails to show a motivation to combine Santoro and Hibino, and that the rejection contains an impermissible level of hindsight in its argument for obviousness. As stated in MPEP § 2145:

"Applicants may argue that the examiner's conclusion of obviousness is based on improper hindsight reasoning. However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleamed only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971)."

Applicant asserts that the rejection relies only on knowledge gleaned from Applicant's disclosure in contravention of the MPEP. If Hibino is combined with Santoro as the Office Action suggests, unnecessary cost and incompatible materials are added to Santoro because Hibino requires the following items:

- a film displacement device that displaces a developed film which has a magnetic recording layer to an image area;
- an image signal conversion device that converts an image of a film frame into an image signal;
- a magnetic writing device that rewrites old data written in a magnetic recording layer of film into new data;
- a data storage circuit that stores old data and new data;

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- an image signal generation circuit that generates a second image signal that shows data change information;
- a control circuit that controls the magnetic writing device, the data storage circuit, and the film displacement device.

Santoro never teaches, nor does Santoro have any use for, the above items. Therefore, the Office Action's combination of Santoro and Hibino without motivation clearly shows that Applicants' claimed invention was rejected based upon the use of impermissible hindsight.

The independent claims are directed to "displaying graphical images" with limitations comprising:

- retrieving a thumbtable matrix, the thumbtable matrix including one or more thumbnails organized in a first matrix configuration;
- displaying the thumbtable matrix on a display window; and
- displaying a first larger image corresponding to a first thumbnail on the display window concurrently with the displayed thumbnails.

Regarding the third element of Applicant's claim 1, Applicant claims "displaying a first larger image corresponding to a first thumbnail on the display window concurrently with the displayed thumbnails." The Office Action uses Hibino to reject Applicant's third element of claim 1, stating that Hibino discloses the third element in column 5, lines 19-40. After further review of the particular reference in Hibino, Hibino never teaches or suggests displaying a larger image concurrently with thumbnails on a single display window. Rather, the reference discusses Figure 44, which includes various frame displays for a user to view,

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none of which include displaying a larger image concurrently with thumbnails. In column 5, lines 19-40, Hibino describes four image-displaying modes, which are as follows.

- a) Displaying a frame number (e.g., "1," "2," etc.) for each frame whose corresponding magnetic information is modified. In this mode, Hibino teaches only displaying numeric values that correspond to a film frame, and never teaches or suggests displaying thumbnails, let alone displaying a larger image concurrently with thumbnails.
- b) Displaying all frame numbers in a film strip and highlighting the frame numbers whose corresponding magnetic information are modified. In this mode, Hibino again teaches only displaying numeric values that correspond to a film frame, and never teaches or suggests displaying thumbnails, let alone displaying a larger image concurrently with thumbnails.
- c) Displaying all frame thumbnails in a film strip and highlighting the frame thumbnails whose corresponding magnetic information are modified. In this mode, Hibino teaches displaying thumbnails on a screen but, however, Hibino never teaches displaying a larger image concurrently with the thumbnails.
- d) Displaying a frame number and its contents (e.g., print type, date, etc) for each for each frame whose corresponding magnetic information is modified. In this mode, Hibino teaches only displaying numeric values that correspond to a film frame along with text that corresponds to a film frame's magnetic information. Hibino never teaches or suggests displaying thumbnails,

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let alone displaying a larger image concurrently with thumbnails in this mode.

As can be seen above and in viewing Figure 44, the Office Action's reference to Hibino never teaches or suggests displaying a larger image concurrently with thumbnails on a single display window as claimed by Applicant. As a note, in Figures 40 and 41, Hibino shows different screen displays whereby two of the screen displays are larger images (Figure 40a/41a and 40c/41c) and one of the screen displays includes thumbnails (Figure 40b/41b). However, Hibino teaches that these are three different screen displays and that a user navigates from one screen display to another screen display. Hibino solidifies this point by using three separate figures (a, b, and c) to illustrate the three different screen displays. This is completely different than Applicant's invention as claimed, in that Applicant displays thumbnails AND a larger image concurrently on the same display window.

The Office Action states that Santoro does not teach Applicant's third element of claim 1, and indeed it does not. Therefore, since neither Santoro nor Hibino, either alone or in combination with one another, teach or suggest all the limitations of Applicant's claim 1, claim 1 is allowable over Santoro in view of Hibino. Claim 8 is an information handling system claim including the same limitations of claim 1 and, therefore, is allowable for the same reason as claim 1. Claim 14 is a computer program product claim including the same limitations of claim 1 and, therefore, is allowable for the same reason as claim 1.

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Notwithstanding the fact that claim 3 is dependent upon claim 1 and therefore allowable for the same reasons as claim 1, claim 3 adds the limitations to claim 1 of:

- identifying a horizontal scroll configuration;
- selecting a next scroll button;
- determining whether the thumbtable matrix is displaying a last thumbnail; and
- scrolling the thumbtable matrix in response to the determination.

Applicant claims "identifying a horizontal scroll configuration," which corresponds to Applicant's invention scrolling in a horizontal direction. The Office Action contends that Santoro teaches all the limitations included in Applicant's claim 3, and uses column 10, lines 1 through 34 in Santoro as a basis for rejecting claim 3. However, upon closer inspection of the reference, Santoro never teaches or suggests any of Applicant's claim 3 limitations, let alone "identifying a horizontal scroll configuration." Rather, column 10, lines 1 through 34 discuss a tile data structure that does not even include a scroll button or a thumbtable matrix.

The Office Action does not state that Hibino teaches any of the elements of Applicant's claim 3, and indeed it does not. Therefore, since neither Santoro nor Hibino, either alone or in combination with one another, teach or suggest all the limitations of Applicant's claim 3, claim 3 is allowable over Santoro in view of Hibino. Claim 16 is a computer program product claim including the same limitations of claim 3 and, therefore, is allowable for the same reason as claim 3.

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Each of the remaining claims 2, 4-7, 9-13, 15, and 17-20 each depend, directly or indirectly, on one of the allowable independent claims 1, 8, and 14. Therefore, claims 2, 4-7, 9-13, 15, and 17-20 are also allowable for at least the same reasons that their respective independent claims are allowable.

CONCLUSION

As a result of the foregoing, it is asserted by Applicant that the amended claims in the Application are in condition for allowance, and Applicant respectfully requests an early allowance of such claims.

Applicant respectfully requests that the Examiner contact the Applicant's attorney listed below if the Examiner believes that such a discussion would be helpful in resolving any remaining questions or issues related to this Application.

Respectfully submitted,

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